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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,583	01/11/2001	Karl-Heinz Eberhardt	1370/11	4078

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EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/743,583

Applicant(s)

EBERHARDT, KARL-HEINZ

Examiner

Harish T Dass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood: cash-issuing, information--carrier-writing, etc.

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 1, last paragraph, claim 6 last phrase, claim 8 last paragraph, claim 12, claim 13 3rd paragraph, the phrase "and/or" renders the claims indefinite because, it is unclear whether the limitations following the phrase are

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part of the claimed invention. See MPEP § 2173.05(d). For purpose of examination only, Examiner assumes that the claim limitation is "or".

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 rejected under 35 U.S.C. 102(e) as being anticipated by Owens et al (hereinafter Owens – US 6,164,638).

Re. Claim 1, Owens substantially discloses the current invention related to automated banking machines (ATM) in detail [see entire document particularly, Abstract; Figures 1-2, 63-70; C1 L4 to C2 L64; C3 L50-L59; C8 L1 to C9 L12; C11 L47 to C12 L3; C32 L11-L67; C34 L9-L22], having a customer identification device which is designed to record customer-specific information [C11 L47 to C12 L3; fig. 64], having an input point for identifying the customer and for describing a cash-issuing transaction [C1 L45-50; C11 L47 to C12 L3], having a cash-issuing device [C2 L12-14; C32 L22-L26]; and having at least one data processing device for controlling the cash-issuing device as a function of

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input signals which are generated [C32 L37-L50] or prepared by the first customer identification device, by the input point and by a data source, wherein the input point or a further input point, for identifying a customer and for describing a cash-issuing transaction and in addition a second customer identification device, which is also designed to record customer-specific information, are arranged at the location of a workstation which is occupied by an employee; the aforesaid customer identification device is arranged at the location of the processing station for the cash-issuing transaction; the results of the recording of a customer-specific piece of information by the first customer identification device and by the second customer identification device can be supplied to a comparator device; and the at least one data processing device is provided at the location of the workstation which is occupied by an employee or at the location of the point at which the cash-issuing transaction is executed or at a remote location, and is controlled itself, to the effect that the enabling of the cash-issuing device, by a positive comparison result of the comparator device [C1 L4 to C2 L64; C3 L50-L60; C8 L1 to C9 L12; C11 L47 to C12 L3; C32 L11-L67; C34 L9-L22;].

Re. Claims 2-4, Owens discloses wherein the comparator device is situated at the location of the first customer identification device, wherein the comparator device is situated at the location of the second customer identification device, and wherein the comparator device is situated at the location of a remotely installed data processing device [C17 L64; C18 L6].

Re. Claim 5 Owens discloses wherein the first customer identification device, a first input point, the cash-issuing device and first data processing device are components of an ATM, which is known per se [C1 L16-L26; C11 L47 to C12 L3; C32 L11-L67;].

Re. Claim 6 Owens discloses wherein the first customer identification device each respond to a password input, a finger print, the inputting of an optically readable signature, a voice test input or to some other input which can be evaluated biometrically [C11 L47 to C12 L3; C32 L11-L67].

Re. Claim 7 Owens discloses wherein the first customer identification device is connected to a detector which responds to a customer-specific information input which is different from a check card input, and activates a switch which switches over the point at which cash-issuing transactions are executed, formed by an ATM, from a connection to a server or to a data network to a connection to the workstation which is occupied by an employee, and/or additionally sets up said connection [C13 L37-L49 C11 L47 to C12 L3; C32 L11-L67].

Re. Claim 8 Owens discloses wherein the input point for preparing the point at which cash-issuing transactions are executed is designed for paying out and, in addition, an information--carrier-writing apparatus (printer) for producing customer-assigned information carriers is located at the location of the workstation which is occupied by an employee, none of said information carriers containing data describing a cash-issuing

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transaction [C8 L3-L67; C11 L47 to C12 L3; C32 L11-L67], and the customer identification device at the location of the point at which cash-issuing transactions are executed is designed to read the information carriers produced by the information-carrier-writing apparatus, and these information carriers can be retained there or deleted after being detected and read [C32 L11-L67].

Re. Claim 9 Owens discloses, wherein a first customer identification device, a first input point, the cash-issuing device and a first data processing device are components of an ATM, which is known per se [C1 L16-L26; C11 L47 to C12 L3; C32 L11-L67].

Re. Claim 10 Owens discloses, wherein a password-inputting device (keyboard) or a fingerprint sensor or a signature scanner or a voice analyzer or a device which operates according to other biometric methods is situated at the location of the workstation occupied by an employee as a specific customer identification device [C11 L47 to C12 L3].

Re. Claim 11 Owens discloses wherein the location of the workstation which is occupied by an employee and the location of the point at which cash-issuing transactions are carried out are connected via data lines via which result signals corresponding to the comparison between certain of the aforesaid input signals, and additionally acknowledgement signals for confirming operating states of the customer identification device or devices and the cash-issuing device, and timing control signals, in particular

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time window signals for specifying time limits for the execution of processing time periods of the respective business transaction, can be transmitted [C8 L3-67; C11 L47 to C12 L3; C32 L11-L67].

Re. Claim 12 Owens discloses wherein the customer identification device of the ATM is designed such that it deletes or retains (stores) information carriers which are written to by the information-carrier-writing apparatus of the workstation which is occupied by an employee, on the basis of a particular identification of the same after their evaluation [Abstract; C8 L3-67].

Re. Claim 13 Owens discloses which contains a customer identification device for recording customer-specific information, an input point for identifying the customer and for describing a cash-issuing transaction, a cash-issuing device and a connection to a data processing device for controlling the cash-issuing device as a function of input signals which are generated or prepared by the customer identification device, by the input point and by a data source, in particular using an. ATM [Figures 1-2, 63-70; C1 L4 to C2 L64; C3 L50-L59; C8 L1 to C9 L12; C11 L47 to C12 L3; C32 L11-L67; C34 L9-L22], data corresponding to a customer account, an amount which is to be paid out and, independently thereof, customer-identifying data, are input at the location of a workstation which is occupied by an employee and which is equipped with an input point [C1 L4 to C2 L64; C8 L1 to C9 L12], the customer-identifying data are tested and the data relating to the amount which is to be paid out are tested by means of a

transactions record file, in the [C1 L4 to C2 L64; C8 L1 to C9 L12] or in a data processing device which is provided at the location of the workstation occupied by an employee or at the location of the point at which cash payment transactions are executed or at a remote location, the test result and the data corresponding to the amount which is to be paid out are transmitted to the payment device, the customer-identifying data are input into the payment device, at its input point, the correspondence between the latter data and the customer-identifying data which are input at the workstation which is occupied by an employee is checked, and given a positive check result, the payment is initiated, and account records are processed in the or a data processing device [C1 L4 to C2 L64; C3 L50-L59; C8 L1 to C9 L12; C11 L47 to C12 L3; C32 L11-L67; C34 L9-L22].

Re. Claim 14 Owens discloses wherein the customer-identifying data which are input at the payment device are transmitted to the data processing device and compared there with the customer-identifying data which are input at the workstation which is occupied by an employee, and in that in the case of a positive result, the payment at the payment device is controlled from the data processing device [C1 L4 to C2 L64; C3 L50-L59; C8 L1 to C9 L12; C11 L47 to C12 L3; C32 L11-L67; C34 L9-L22].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

US 6,338,048 to Mori, January 8, 2002 "Electronic transaction system", discloses an electronic transaction system for depositing currency to a financial institution such as a bank, storing a value corresponding to this currency as money information (electronic money) in a card (IC card) mounted with an integrated circuit and settling the cost by withdrawing from electronic money stored on the IC card when paying at the time of a business transaction such as the purchase of goods.

US 5,386,103 to DeBan et al, Jan. 31, 1995 "Identification and verification system", discloses an invention to provide for an improved customer identification and verification system for verifying individual identity before access is granted to a facility or a transaction such as cashing of documents, such as checks.

US 5,933,816 to Zeanah et al, August 3, 1999 "System and method for delivering financial services", discloses a system and method for delivering financial services to a remote device. Through the remote device, a customer or employee of a financial institution can select a mini-app dialog component to perform a function. Preferably, each function that may be performed is represented by a separate mini-app dialog component. Upon selection of a function, the mini-app dialog component collects information needed to perform the requested function and instantiates a transaction executor component to carry out the function. The remote device may comprise any type of device, such as a personal computer, screen phone, ATM, personal data assistant, or an internal staff terminal. The remote device may access the system in a variety of ways,

such as through an external service provider, through the Internet, or through dial-up access. Thus, the system provides a single base for interfacing with all types of remote devices.

US 6,289,320 to Drummond et al, Sept. 11, 2001 "Automated banking machine apparatus and system", this invention relates to automated banking machines.

Specifically this invention relates to an automated banking machine apparatus and system that is capable of use in a wide area network, which provides a user with a familiar interface from their home institution at banking machines operated by other institutions, and which provides greater options for machine outputs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass

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Examiner

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4/15/04


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